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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,585	02/09/2001	Colin Leslie Young	032642-004	5719

21839 7590 08/04/2003

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EXAMINER

PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 08/04/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application N .	Applicant(s)
	09/762,585	YOUNG, COLIN LESLIE
	Examiner	Art Unit
	JOHN D PAK	1616

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 28 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) The period for reply expires 3 months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. Applicant's reply has overcome the following rejection(s): _____.
4. Newly proposed or amended claim(s) ____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 89-91.

Claim(s) rejected: 55-88 and 92-95.

Claim(s) withdrawn from consideration: 96.

8. The proposed drawing correction filed on ____ is a) approved or b) disapproved by the Examiner.

9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.

10. Other: _____.


JOHN PAK
PRIMARY EXAMINER
GROUP 100

Continuation of 2. NOTE: (1) There is an indefiniteness or lack of clarity problem with the use of "consisting" in the amendment of 7/28/03. For example, independent claim 76 recites a composition "consisting of" an metal oxalate and an [sic] suitable carrier." This means further description of the composition must be consistent with such "consisting of" language. However, in claims 83-84, the carrier is recited in terms of "comprises." Worse, claim 85 has "further consisting" of a fungicide. This is not possible -- consisting language in the independent claim closed off any additional ingredients. "Comprises" and "further consisting" language cannot be used once "consisting" is used. Applicant is advised that these specifically noted errors are merely exemplary. Additional such errors are evident in numerous other claims. (2) Even assuming arguendo that applicant did submit a properly dependent set of claims wherein the composition were correctly limited to "consisting of an effective amount of a substantially insoluble metal oxalate and an [sic] suitable carrier therefor," such narrowing of claims is deemed untimely at this after-final stage of prosecution. The prior art-based rejection of record relies on a composition that comprises such metal oxalate. The "consisting of" limitation was never before presented, and therefore, a new prior art search and ground of rejection (if any) with respect to that feature would be necessary. For example, the claims would read on a simple aqueous suspension of metal oxalate. Previously, the closest antifouling prior art reference was applied, because there was no need to consider a "consisting of" language. Now, if the amendment were to be granted entry, that prior art based rejection would have to be withdrawn, and possibly other composition per se that may not be related to antifouling may have to be searched for and applied. Applicant has been given two Office actions on the merits of the claims as formerly presented. At this after-final stage of prosecution, the proposed amendment is deemed untimely.